



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/945.705 02/23/97 YAMADA

M JP6-131165

IM31/1217
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EXAMINER

MEDLEY.M

ART UNIT

PAPER NUMBER

1721

DATE MAILED:

8
12/17/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/945,705

Applicant(s)
YAMADA, MICHIIYA, ET AL

Examiner
Margaret B. Medley

Group Art Unit
1721



☒ Responsive to communication(s) filed on Sep 21, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER
GROUP 1100-1721

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The Abstract of disclosure filed with the amendment received in the Office on September 21, 1998 has been made a permanent part of the record and satisfy the requirement of the missing abstract.

The 35 U.S.C. 112, second paragraph rejection previously made of record is withdrawn.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 for reasons made of record in the last Office action remain rejected under 35 U.S.C. 103(a) as being unpatentable over Igarshi et al. 5,281,347 in view of Umemura et al. 4,692,256, Rowman et al. 4,360,438, Papay et al. 4,178,258, Ward, Jr. 4,846,983, Farmer et al. 3,509,051, LeSuer 3,254,025 and White 4,330,420.

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LeSuer further disclosures the claimed specific zinc primary and/or secondary alkyl dithiophosphates in combination with the claimed (c) and (d) components providing the teachings to use its zinc component, (c) and (d) component as the component of Igarashi et al. because the component are well-known component conventional used in lubricant compositions for the same intended functions as Igarashi et al. lubricant components. LeSuer provides the motivation and teachings for using zinc primary alkyl dithio phosphates⁴⁵ Igarashi et al. zinc alkyl dithiophosphates.

The disclosure is objected to because of the following informalities: In line 2 after Tables I and II C₁₈ should be corrected to read C₁₃.

Appropriate correction is required.

Claim 2 is objected to because of the following informalities: In line 7 of claim 2(b) 'atoms' spelling should be corrected. Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 (and its dependent claims) and claim 2 (and its dependent claims) are indefinite and confusing for the (b) zinc dialkyldithio-phosphate component Markush grouping is confusing and unclear and does not appear to be supported by the paragraph bridging pages 6 and 7 of the present specification.

Applicant's arguments filed September 21, 1998 have been fully considered but they are not persuasive.

Applicants' arguments have been reviewed and reconsidered, however arguments unsupported by factual evidence do not take place of objective evidence of unobviousness. Applicants have not shown that the friction reducing properties are attributed to a particular alkyl group present on the ZDDP component which is commensurate in scope with the experimental data results shown in Tables I and II the present specification and the claims as drafted. The secondary references clearly teaches the conventional use of well-known zinc primary and secondary and primary mixture dialkyl dithiophosphates in lubricant oil compositions. The claims are not commensurate in scope with the tested experimental data results argued therein.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret D. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday-Thursday from 7:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharon Gibson, can be reached on (703) 308-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3559.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Margaret D. Medley.cb
Primary Examiner

December 15, 1998

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER
GROUP 1100 -/121